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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/749,972	12/28/2000	Martin Karl Russel Burnham	GM10201-D1	7984
25308	7590	07/14/2004	EXAMINER	
			RAO, MANJUNATH N	
		ART UNIT		PAPER NUMBER
		1652		
DATE MAILED: 07/14/2004				

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Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>
	09/749,972	BURNHAM ET AL.
	<b>Examiner</b>	<b>Art Unit</b>
	Manjunath N. Rao, Ph.D.	1652

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 06 November 2001.
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 11-22 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) 11-14 is/are allowed.
- 6) Claim(s) 15-22 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) All    b) Some \* c) None of:
    1. Certified copies of the priority documents have been received.
    2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | Paper No(s)/Mail Date. _____  |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>12/28/00</u> | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
|   | 6) <input type="checkbox"/> Other: _____                                    |

### **DETAILED ACTION**

Claims 11-22 are currently pending in this application which were suspended by the Examiner in view of a reference that was due to become available. The application has been removed from the suspended status as the reference has now become available. An Office action follows.

#### ***Election/Restrictions***

Applicant's election without traverse of Group I in the reply filed on 11-6-01 is acknowledged.

#### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 15-22 are rejected under 35 U.S.C. 102(e) as being anticipated by Doucete-Stamm et al. (US 6,699,703). This rejection is based upon the public availability of a patent to another. Claims 15-22 of the instant application are drawn to a polynucleotide encoding a polypeptide comprising or consisting of SEQ ID NO:2, vectors and host cells comprising the same and a method of making said polypeptide using said host cells. Doucete-Stamm et al. disclose a polynucleotide

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with SEQ ID NO:2480 that encodes a polypeptide (SEQ ID NO:5141) that is 100% identical to SEQ ID NO :2 (see enclosed sequence alignment) along with vectors and host cells comprising the same and a method of making said polypeptide using said host cells. Therefore Doucete-Stamm et al. anticipate claims 15-22 as written.

Claims 15-22 are rejected under 35 U.S.C. 102(a) as being anticipated by Barash et al. (WO 9818931-A2, 5-7-1998). This rejection is based upon the public availability of a publication. Claims 15-22 of the instant application are drawn to a polynucleotide encoding a polypeptide comprising or consisting of SEQ ID NO:2, vectors and host cells comprising the same and a method of making said polypeptide using said host cells. Barash et al. disclose a polynucleotide which encodes a polypeptide that is 100% identical to SEQ ID NO :2 (see enclosed sequence alignment that is identical to that disclosed by Doucete-Stamm et al.) along with vectors and host cells comprising the same and a method of making said polypeptide using said host cells. Therefore Barash et al. anticipate claims 15-22 as written.

***Allowable Subject Matter***

Claim 11-14 are allowable.

Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Manjunath N. Rao, Ph.D. whose telephone number is 571-272-0939. The Examiner can normally be reached on 7.00 a.m. to 3.30 p.m. If attempts to reach the examiner by telephone are unsuccessful, the Examiner's supervisor, Ponnathapura Achutamurthy can be reached on 571-272-0928. The fax phone numbers for the organization

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where this application or proceeding is assigned is 703-872-9306 for regular communications and for After Final communications. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 571-272-1600.

A handwritten signature in black ink, appearing to read "Manjunath".

Manjunath N. Rao  
July 6, 2004

RESULT 2  
 US-09-583-110-5141  
 Sequence 5141, Application US/09583110 → Now US 6,699,703B1.  
 GENERAL INFORMATION:  
 APPLICANT: Lynn Doucette-Stamm et al.  
 TITLE OF INVENTION: Nucleic Acid and Amino Acid Sequences Relating to Streptococcus  
 FILE REFERENCE: PATH00-07A  
 CURRENT APPLICATION NUMBER: US/09/583,110  
 PRIOR APPLICATION NUMBER: US 09/107,433  
 PRIOR FILING DATE: 1998-06-30  
 PRIOR APPLICATION NUMBER: US 60/085,131  
 PRIOR FILING DATE: 1998-05-12  
 PRIOR APPLICATION NUMBER: US 60/051,553  
 PRIOR FILING DATE: 1997-07-02  
 NUMBER OF SEQ ID NOS: 5322  
 SEQ ID NO: 5141  
 LENGTH: 212  
 TYPE: PRT  
 ORGANISM: Streptococcus pneumoniae  
 US-09-583-110-5141

Query Match 100.0%; Score 1053; DB 19; Length 212;  
 Best Local Similarity 100.0%; Pred. No. 5.9e-10;  
 Matches 212; Conservative 0; Mismatches 0; Indels 0; Gaps 0;  
 Qy 1 MSKGFLVSLEREGEGAKTSVLEALPILEENGVETITREPGVVLIGEKIREVILDPST 60  
 Db 1 MSKGFLVSLEREGEGAKTSVLEALPILEENGVETITREPGVVLIGEKIREVILDPST 60  
 Qy 61 QMDAKFELLYIASRQHLVKEVLPALAEAGKIVIMRPISSVAQGFGRLDIAIDWL 120  
 Db 61 QMDAKFELLYIASRQHLVKEVLPALAEAGKIVIMRPISSVAQGFGRLDIAIDWL 120  
 Qy 121 NQFATGQLKPDTLYDIEVEVGLARTAANSDEVRNLDLJEGDLIKKVROGYLSLIDKE 180  
 Db 121 NQFATGQLKPDTLYDIEVEVGLARTAANSDEVRNLDLJEGDLIKKVROGYLSLIDKE 180  
 Qy 181 GRIIVKIDASLPLEQVYETTKAVLFEDGLAK 212  
 Db 181 GRIIVKIDASLPLEQVYETTKAVLFEDGLAK 212

